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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,198	09/09/2003	Tetsujiro Kondo	238872US6	9129

22850 7590 03/20/2007  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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AN, SHAWN S

ART UNIT	PAPER NUMBER
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2621

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/20/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/20/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/657,198	<b>Applicant(s)</b> KONDO ET AL.	
	<b>Examiner</b> Shawn S. An	<b>Art Unit</b> 2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/16/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 21-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claims 21-23** are directed to a computer readable carrier including program instructions that cause a computer to perform a predetermined predictive calculation as recited in preambles, but the body of the claims is directed to a series of steps drawn such as to solve of a mathematical problem and manipulating an abstract idea without practical application that produces any useful, tangible, and concrete results.

Furthermore, preambles of claims 22-23 are also directed to non-statutory subject matter.

Some helpful suggestions to overcome non-statutory subject matter.

22. A computer readable memory medium embodied with ~~carrier including~~ computer program instructions that cause a computer to perform a predetermined predictive calculation on input data using a predictive coefficient, the computer program comprising: ....

As per claim 23, since amending claim limitations to make the claim in conformance with statutory subject matter would most likely resemble claim 22 (since body of the claim is identical with respect to claim 23) as proposed above, the Examiner suggests that claim 23 should be canceled.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 8, 11, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kondo et al (5,852,470)

**Regarding claims 1 and 11**, Kondo et al discloses a data processing apparatus for performing a predetermined predictive calculation on input data using a predictive coefficient, comprising:

first storing means (first memory) (Fig. 4, 14) for storing a first predictive coefficient obtained by learning (col. 5, lines 17-22);

instructing means (a designation unit) (12) for instructing conversion of the first predictive coefficient (col. 5, lines 2-25; col. 7, lines 23-26; col. 11, lines 6-13 and lines 51-67; col. 12, lines 1-7); and

first calculating means (coefficient calculation unit) (13) for calculating a second predictive coefficient from the first predictive coefficient according to a predetermined transform method (DCT) when conversion is instructed by the instructing means (col. 24, lines 18-26).

**Regarding claims 8 and 18**, Kondo et al discloses the instructing means (12) designating the transform method, and the first calculating means (13) calculating the second predictive coefficient from the first predictive coefficient stored by the first storing means (14) according to the transform method (DCT) instructed by the instructing means (col. 24, lines 18-26).

***Allowable subject matter***

5. Claims (2-7, 9-10) and (12-17, 19-20) are objected to as being dependent upon rejected base claims 1 and 11, respectively, but would be allowable:

if either claim 2 or claim 9 is rewritten in independent form including all of the limitations of the base claim 1 and any intervening claims; and

if either claim 12 or claim 19 is rewritten in independent form including all of the limitations of the base claim 11 and any intervening claims.

**Dependent claim 2 and 12** recite a novel feature of the first calculating means calculating and outputting the second predictive coefficient when conversion is instructed by the instructing means, and outputting the first predictive coefficient without calculation of the second predictive coefficient when conversion is not instructed by the instructing means, wherein the prior art of record fails to anticipate or make obvious the novel feature.

**Dependent claims 9 and 19** recite a novel feature, wherein the first calculating means includes a third storing means (memory) for storing a transform formula corresponding to the transform method and for selecting the transform formula according to the transform method designated by the instructing means, and calculates the second predictive coefficient from the first predictive coefficient based on the transform formula stored by the third storing means (memory), wherein the prior art of record fails to anticipate or make obvious the novel feature.

Accordingly, if the amendments are made to the claims listed above, and if rejected claims are canceled, the application would be placed in a condition for allowance.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

A) Kondo et al (5,781,238), Information signal encoding apparatus.

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7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Shawn S An* whose telephone number is 571-272-7324.

8. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**SHAWN AN**  
**PRIMARY EXAMINER**

3/14/07